REMARKS

In the October 27, 2010 Final Office Action the Examiner maintained the rejection of claims 1-4, 6-13, 19-21, 23-25, and 27-29, and included without discussion new claims 30 and 31 in the rejection under 35 U.S.C. §103(a) as being unpatentable over Szabo et al. (US 6,531,464) in view of Arnon et al. (US 6,214,791) and Kerwar et al. (US 4,617,319). See October 27, 2010 Final Office Action.

In response, Applicant respectfully points out that there is no rationale for the rejection of independent claim 30 and of independent claim 31 set forth in the statement of rejection under 35 U.S.C. §103(a). Because no reasons of record justify the rejection of claims 30 and 31, inclusion of these claims in the rejection is improper. With respect to claims 1-4, 6-13, 19-21, 23-25, and 27-29, applicants maintain and reiterate by reference herein their previous arguments in favor of patentability of these claims.

All elements of the claimed methods must be given examination on the record.

Independent claim 30 and independent claim 31 each recite elements which the prior art, even when combined, do not teach. The Examiner's statement of rejection in the October 27, 2010 Final Office Action does not explain how the combined prior art teaches each and every element of each of claims 30 and 31. See e.g. In re Wada and Murphy, Appeal No. 2007-3733 (January 14, 2008), ("Because the Examiner has not explained why every limitation in claim 1 would have been obvious to a person of ordinary skill in the art, we agree with Appellants that the Examiner has not made out a case of prima facie obviousness.") See also Ex parte Fred Wehling, Appeal No. Appeal 2009-008111

(May 17, 2010), ("The dispositive issue in this case is whether the Examiner has explicitly articulated a prima facie case of obviousness which addresses all of the limitations of the claimed invention.")

Independent Claim 30 requires that "administration of mitoxantrone precedes the administration of glatiramer acetate by approximately 2 weeks through approximately 10 weeks." Independent claim 31 requires that glatiramer acetate be administered to a subject "treated by mitoxantrone administration", "by daily subcutaneous injection", beginning "two weeks after the last administration of mitoxantrone." See Amendment in Response to April 13, 2010 Office Action at page 5. The Examiner's arguments relating to claims reciting the "substantially preceding" language of claim 1 do not apply to independent claims 30 and 31 which recite more specific timing limitations, and other elements for which no mention in the prior art is noted and for which no rationale for rejection has been articulated.

In view of the foregoing, applicant respectfully submits that the Examiner has failed to meet the necessary burden of establishing a *prima facie* case of obviousness for independent claims 30 and 31. Accordingly, applicant's rebuttal evidence that there would be no reasonable expectation of success, that the art teaches away from the invention as claimed, and that the claimed methods produced unexpected results need not be further elaborated herein.

Accordingly, applicants maintain that the independent claims 30 and 31 define an invention not obvious in view Szabo et al., Arnon et al., and Kerwar et al. whether taken singly or in combination, and therefore not properly rejected under 35 U.S.C. 103(a). Applicant respectfully requests that the Examiner

reconsider and withdraw the rejection of claims 30 and 31.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this response. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

Gary J. Gershik

John P. White
Registration No. 28,678
Gary J. Gershik
Registration No. 39,992
Attorney for Applicants
Cooper & Dunham LLP
30 Rockefeller Plaza
20th Floor
New York, New York 10112
(212) 278-0400

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I hereby certify that this correspondence is being transmitted via the Electronic Filing System (EFS) to the U.S. Patent and Trademark Office on December 10, 2010.

Geoffry Knudsen